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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957

No. 347

EUPHIME V. BERESLAVSKY,
Petitioner,

v.

THE UNITED STATES,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

PETITIONER'S REPLY BRIEF

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Respondent's statements of the "Question Presented" obviously have no foundation in fact. With regard to Question 1 the Court of Claims specifically found that the patentee was entitled to a patent "covering his discovery that mesitylene in addition to that found in gasoline would prevent a knock" (R. 25) and that claim 1 of the patent was valid. Petitioner is not asking a review of the Court's decision on validity. Petitioner, however, is glad to join with the respondent in asking this Court to review the entire proceedings in the Court of Claims.

With regard to Question 2 it is apparent from the patent itself, which appears *in toto* on page 3 of respondent's brief, that there is no foundation for respondent's statement that the patent "contemplated the addition to gasoline of the substance mesitylene in the amount of 5-20% of the total volume of the liquid". The only quantitative values in the patent are those given "by way of example,"

viz., that "20 grams of diamino-mesitylene added to one gallon of gasoline will suppress a knock in present-day automobile engines and generally will permit increasing the compression pressure of the engine about 20 pounds."

Respondent's question correctly stated, is "Whether petitioner's patent which gives 'by way of example' the use of enough mesitylene to permit increasing the compression pressure of the engine twenty pounds, is infringed by the addition to aviation gasoline of a compound containing sufficient mesitylene to permit increasing the compression pressure one or two pounds". The *scope* of the patent is in nowise affected by the figures selected in stating the specific example. If, instead of saying 20 grams of diamino-mesitylene per gallon of gasoline will permit increasing the compression pressure 20 pounds, the patent had said 1 gram of diamino-mesitylene per gallon of gasoline will permit increasing the compression pressure one pound, the stated proportion would have been precisely the same. More fully stated the question is:

Is there no infringement because the respondent used the CTC mixture containing mesitylene as its most effective anti-knock additive in order to permit raising the compression ratio the final one or two pounds, and used, in addition, other substances to the extent that they were available to obtain the ultimate desired octane value, and thereby produce the maximum quantity of aviation gasoline?

The statement at the bottom of page 2 of respondent's brief that the Commissioner found it unnecessary to pass upon the issue of infringement, is not correct. As appears from the record (R. 9) the Commissioner was in the first instance directed to report his recommendations for conclusions of law as well as findings of fact with respect to the question of validity only. After the patent was found to be valid by the Court of Claims, the case was remanded for findings of fact and recommended conclusions with respect to the question of infringement. The dismissal of

plaintiff's petition by the Court of Claims is based solely on a finding of non-infringement (R. 66).

The respondent states on page 8 of its brief that the petition raises no issue of law, general or specific, to warrant a review by this Court. So far as we are aware, this Court has never decided the specific question presented here, namely, whether infringement of a patent covering the use of a particular substance to obtain a specified result is avoided by using in conjunction with such substance other substances having equivalent properties whereby the total result accomplished is in part only attained by the patented substance. In the respondent's aviation gasoline, tetra ethyl lead was used to the full extent that it could be without corroding the engine parts, and other hydrocarbons whose anti-knock properties for the most part were discovered subsequent to applicant's patent, were also used. But the mesitylene in the CTC mixture by the undisputed stipulated evidence contributed its part to the anti-knock value of the aviation gasoline and such use was just as much an infringement as if each thousand gallons of mesitylene were added in the proportion of 5% to 20,000 gallons of gasoline instead of in the proportion of five-tenths of one percent to two hundred thousand gallons of aviation gasoline.

On pages 8, 9 and 10 of its brief respondent vehemently asserts that the patent in suit is invalid. As stated above, petitioner will be glad to have this Court review the conclusion of the Court of Claims that the patent is valid. We are sure that conclusion will be affirmed.

The statement on page 10 of respondent's brief that the Court of Claims sustained the patent as valid over the Taber and Essex patent "because petitioner's additive consisted solely of mesitylene or one of its compounds" is clearly not so. The Court of Claims sustained the patent as valid over Taber and Essex because that patent did not disclose the patentee's discovery that mesitylene

and its amino compounds were highly effective anti-knock additives (R. 25).

The statement on page 10 of respondent's brief that the Court sustained the patent by interpreting the claim as limited to the proportions stated in the patent, is also contrary to the facts. See finding 14 of the Court's opinion on the issue of validity:

> "14. While the patent in suit states, by way of an example, 20 grams of diamino-mesitylene added to 1 gallon of gasoline, the patent is not limited to any specific proportionate mixture of mesitylene with gasoline, nor is the claim in suit in any way limited to any proportionate mixture" (R. 32).

Apparently on the trial of the issue of infringement the Commissioner was misled into believing that the patent was limited to a specified proportion of mesitylene in the fuel (R. 35, ll. 32-34). In accepting the Commissioner's recommended finding of non-infringement the Court of Claims also was obviously misled, for they say (R. 52) "The specifications of plaintiff's patent called for mesitylene of from 5 to 20 per cent of the total". It is believed the Court was also misled as to the significance of the figures included in the stipulated testimony. The amount of CTC mixture given in the typical formula (R. 101) is merely the ratio of the total amount of CTC mixture used by Sun in compounding the total amount of aviation gasoline of the specified rating. The CTC mixture was used interchangeably with the other anti-knock additives, viz., benzene, toluene, ethyl toluene, xylene, cumene and BTX fractions, each in accordance with its blending value, as stated in the table Exhibit J (R. 113) furnished to the oil companies by the Government. As stated in the stipulated facts (R. 115, ll. 8-12) the amount of any one particular anti-knock additive in a particular shipment of gasoline might vary from zero to 10 per cent or more, depending upon its availability.

The statement on page 11 of respondent's brief that "mesitylene was present, not as a deliberately added anti-knock agent in the concentration contemplated by petitioner, but merely as an incidental constitutent of the CTC distillate" is contrary to the stipulated facts. The average C_9 content of the CTC mixture was 29.5%—a larger percentage than the C_8 group and considerably larger than any other group (R. 41). Mesitylene constituted 26.3% of the C_9 group (R. 42), and with its much higher anti-knock value (R. 113) was the most effective single ingredient of the CTC mixture. The addition of the mesitylene was incidental only if the addition of the entire CTC mixture itself be so regarded.

This Court has in a number of cases held that the scope of a patent is determined by the claims when read in the light of the prior art and the patent specifications.

This Court has also held that infringement is not avoided by departing from the specific example of the patent specification unless the departure goes beyond the scope of the claims when so interpreted.

But we know of no case where the facts were parallel to those presented here, namely, where the patentee's discovery was used in conjunction with other later discoveries so that the *entire* beneficial result is attributable in part only to the patentee's invention.

CONCLUSION

For the foregoing reasons and those stated in our petition, it is respectfully submitted that the petition should be granted.

Respectfully submitted,

W. B. Morton,
Attorney for Petitioner.

September 13, 1957.